

REMARKS

Claims 1-10, 17-19 and 21-22 are pending in this application. Claims 11-16 and 20 have been canceled.

Support for the amendment to claim 1 can be found on page 15, lines 11-12 of the specification.

New claim 22 finds support on page 15, lines 11-12 of the specification.

No new matter has been added by way of the above-amendment.

Rejections under 35 USC §103

Claims 1-18 and 21 have been rejected under 35 USC §103(a) as being unpatentable over Brust '019 (US Patent No. 6,100,019) in view of Nishikawa '977 (US Patent No. 6,077,977). Applicant respectfully traverses the rejection.

The present invention is drawn to a silver halide photographic emulsion comprising grains, wherein not less than 85% of the total projected area of the grains are occupied by tabular grains meeting requirements (i) to (v) below:

- (i) silver bromochloroiodide grains having (111) faces as major surfaces,
- (ii) hexagonal grains having a ratio of the length of an edge having the maximum length to the length of an edge having the minimum length of not more than 2,
- (iii) perfect epitaxial grains having a total of six epitaxial junctions each existing only in each of six apex portions of the hexagonal grains,
- (iv) the silver chloride content is 1 to 6 mol%, and
- (v) the silver iodide content is 0.5 to 10 mol%.

Applicant has provided the Examiner with multiple reasons why the inventive emulsion is patentable over Brust '019 and Nishikawa '977. However the Examiner has maintained her position that the present invention remains obvious.

Accordingly, in order to further distinguish the inventive emulsion from the cited references, Applicant has further amended claim 1 to recite that not less than 85% of the total projected area of the grains are occupied by tabular grains wherein the silver chloride content of the epitaxial portion is 50 mol% or less.

Applicant respectfully submits that Brust '019 fail to teach or suggest this feature of the claims. In fact, Brust '019 teaches that the tabular grains have deposited on their edges, silver halide comprised of **greater than 50 mol%** chloride based on silver. See Brust '019 at column 2, line 66 to column 3, line 2; column 8, lines 9-12; and column 17, lines 51 to 53.

In addition, Nishikawa '977 has been cited for teaching the ratio of side lengths of the grains and the COV of ECD of the grains. Accordingly, Nishikawa '977 fail to cure the deficiencies of Brust '019.

As the MPEP directs, all the claim limitations must be taught or suggested by the prior art to establish a *prima facie* case of obviousness. See MPEP § 2143.03. Since Brust '019 and Nishikawa '977 fail to teach or fairly suggest that not less than 85% of the

total projected area of the grains are occupied by tabular grains wherein the silver chloride content of the epitaxial portion is 50 mol% or less, a *prima facie* case of obviousness cannot be said to exist. As such, withdrawal of the rejection is respectfully requested.

Conclusion

The present application well-describes and claims patentable subject matter. The favorable action of allowance of the pending claims and passage of the application to issue is respectfully requested.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact **Garth M. Dahlen, Ph.D., Esq.** (Reg. No. 43.575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

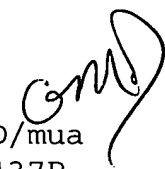
By



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